

REMARKS

Claims 1-16 are pending. Claims 2, 4 and 7 have been amended. Claims 21-24 have been added to further recite applicant's invention. The specification has been amended pursuant to the Examiner's requirements. It is respectfully submitted that these amendments are supported by the application as originally filed including the specification, claims, abstract and the drawings and that no new matter has been added. The Examiner's rejections are addressed in turn.

Claim Rejections under 35 U.S.C. §112

The Examiner rejected claims 2 because the basis of the percentage of the particles was unstated; the Examiner rejected claim 4 because the basis of the percentage of chloride ions was unstated. These claims have been amended to expressly recite that the basis is by weight.

Claim Rejections under 35 U.S.C. §103

The Examiner rejected all pending claims as obvious. The MPEP sets forth the requirements for such a rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP 2142 (citations omitted). If the prior art fails to meet these three criteria, then the prior art likewise fails to establish a *prima facie* case of obviousness.

Claim 1 recites, among other elements, the step of:

removing an exterior portion of the mortar surface after approximately two hours.

In rejecting this claim, the subject Office Action contends that the Nishida et al. teach that "a trowel is used to flatten/remove the raised portions of the layer to provide an aesthetic/decorative effect, while the layer has sufficient plasticity to be worked." (Paper 5, page 5.) Applicant respectfully traverses this rejection.

Nishida et al. teach the use of a roller or trowel to flatten the peaks on a mortar wall. (Column 4, lines 35-53.) Nishida et al. expressly teach that this flattening operation is performed by pressing "a roller or trowel having a flat surface" against the peaks before the mortar has hardened. (Column 4, line 35-53.) Thus, Nishida et al. teach reforming the mortar surface but none of the mortar is actually removed.

In contrast, applicant's claimed invention expressly teaches *"removing an exterior portion of the mortar surface."* Attached as Appendix B, applicant includes an illustration showing this distinction from Nishida et al. The upper figure is a side view of a one-coat mortar before the step of removing and the lower figure is a side view of a one-coat mortar after the step of removing. As shown in Appendix B, the decorative surface taught by applicant's invention is obtained by *"removing"* the surface particles, not by *"reforming"* as taught by Nishida et al. Since Nishida et al. fail to teach this express element of claim 1, it is respectfully submitted that it stands in condition for allowance.

Claim 2 depends from claim 1 and further recites, among other elements, that:

the concrete-based mortar ha[s] ... at least two-percent of particles greater than 1.2 millimeters in diameter.

As shown in Appendix B, applicant's claimed invention removes these larger particles to obtain the decorative surface.

In rejecting this express element of claim 2 the subject Office Action states that Nishida et al. teach aggregate sizes of 75-300 microns, or in their own words "fine [aggregate] powder." Contrary to this teaching, applicant's claimed invention teaches the use of substantially larger particles so that when the surface is scraped and an exterior portion is removed, the trace of these larger particles creates an attractive and decorative surface. Since Nishida et al. teach substantially smaller aggregate sizes *outside* the express range of claim 2, Nishida et al. fail to teach this element. Accordingly, it is respectfully submitted that the applicant has traversed the subject rejection and that this claim stands in condition for allowance.

Claims 3-5 depend from claim 1 or an intermediate claim and recite additional elements. Accordingly, it is respectfully submitted that these claims stand in condition for allowance.

Claim 6 depends from claim 1 and further recites the step of "scraping a rough trowel against the exterior portion of the mortar surface." In rejecting this claim, the subject Office Action again relies on Nishida et al. Specifically, the Examiner contends that "[s]ince column 4, [lines] 48-55 suggest

using tools other than a roller or a flat trowel to surface the coating to form a decorative effect, use of a conventional alternative such as a 'rough' trowel would have been an obvious variation."

The pertinent portion of Nishida et al. states:

In order to form flat areas at the top of the convex portions, a roller or trowel *having a flat surface* is employed. It is preferable to perform the pressing operation by a roller or trowel, prior to the finishing coating in order to obtain an excellent decorative layer.

The pressing operation can be performed by other *similar* methods which do not use a roller or a trowel.

Contrary to the Examiner's argument, a rough trowel could not be substituted as a "similar" method because it would not flatten but rather would roughen the surface. In fact, a rough trowel would create new peaks and so this proposed modification of Nishida et al. flies directly against the express teachings of that reference. Accordingly, it is respectfully submitted that this reference does not support a *prima facie* case of obviousness and that the claim stands in condition for allowance.

Claim 7 recites "removing an exterior portion of the resulting composition." For the reasons set forth above with respect to claim 1, it is respectfully submitted that the applicant has traversed the subject rejection. In addition,

claim 7 has been amended to more clearly distinguish Nishida et al. Specifically, claim 7 now recites that:

the resulting composition sufficiently hardens to prevent reformation...

Unlike Nishida et al. which reforms the surface while it is still plastic, applicant's invention teaches scraping the surface to remove a portion of the composition. This step occurs after the composition hardens because if the composition were still plastic then it would stick to the rough trowel. (Specification, page 14.) On this further ground, it is respectfully submitted that claim 7 stands in condition for allowance.

Claims 8-11 depend from claim 7 or an intermediate claim. Accordingly, it is respectfully submitted that these claims stand in condition for allowance.

Claims 12 and 13 depend from claim 7 and further recite "scraping a rough trowel against the exterior portion of the resulting composition." For the reasons set forth above with respect to claim 6, it is respectfully submitted that the subject rejection of these claims is traversed.

Newly Added Claims

Claims 21-23 have been added to further claim applicant's invention. It is respectfully submitted that these claims recite patentable subject matter and, therefore, stand in condition for allowance.

Restriction Requirement

The Examiner contends that "MPEP 802.01 states two or more distinct inventions may not be claimed in one application." It is respectfully submitted that this misapprehends the import of that citation. This section of the MPEP addresses the "Meaning of 'Independent' and 'Distinct'" under 35 U.S.C. §121 and whether one or both are required to support a restriction requirement. Upon a showing that the claims are independent or distinct, MPEP §803 sets forth the additional requirement for issuing a restriction requirement: "There must be a serious burden on the examiner if restriction is required." The Examiner's stated interpretation of MPEP §802.01 would ignore this additional requirement and would conflict with the plain instruction of MPEP §803. Restriction is only proper with a showing that examination of all claims would place "a serious burden on the examiner." For the reasons set forth in applicant's previous response, it is respectfully submitted that it would not.

Conclusion

For the reasons set forth above, it is respectfully submitted that the application stands in condition for allowance. The Examiner's reconsideration and favorable action are respectfully requested.

Respectfully submitted,

Date: 12/16/02

By: 

Heath W. Hoglund
Registration No. 41,076
256 Eleanor Roosevelt
San Juan, PR 00918
Tel.: (787) 772-9200
Fax: (787) 772-9533

APPENDIX A

In the Specification

Amendment at page 3, line 4:

Chloride ions amount: $25.5 \pm 1.5 \%$ (by weight)

Amendment at page 10, line 9:

According to further aspects of the invention, the concrete-based mortar has, by weight, at least fifty-percent of particles greater than 0.18 millimeters in diameter and at least two-percent of particles greater than 1.2 millimeters in diameter. The accelerant has inorganic salts and halogens and includes, by weight, chloride ions in an amount of approximately twenty-five percent.

In the Claims

2. (Amended) The method of claim 1, wherein the step of mixing the concrete-based mortar comprises mixing the concrete-based mortar having by weight at least fifty-percent of particles greater than 0.18 millimeters in diameter and at least two-percent of particles greater than 1.2 millimeters in diameter.

4. (Amended) The method of claim 3, wherein the step of mixing the concrete-based mortar further comprises mixing the concrete-based mortar with the accelerant having chloride ions in an amount of approximately twenty-five percent by weight of the accelerant.

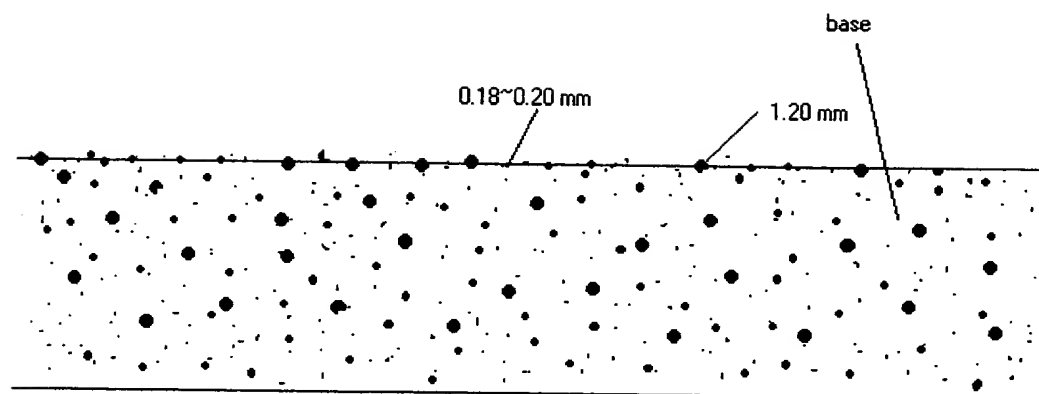
7. (Amended) A method of applying a concrete-based mortar to a building comprising the steps of:

mixing a concrete-based mortar, an accelerant and water to form a resulting composition that sets within three hours;

applying the resulting composition to an exterior of a building;

allowing the resulting composition to set on the building for a period of at least two hours, wherein the resulting composition sufficiently hardens to prevent reformation; and

removing an exterior portion of the resulting composition, wherein the time from applying the resulting composition to removing the exterior portion of the resulting composition does not exceed three hours.

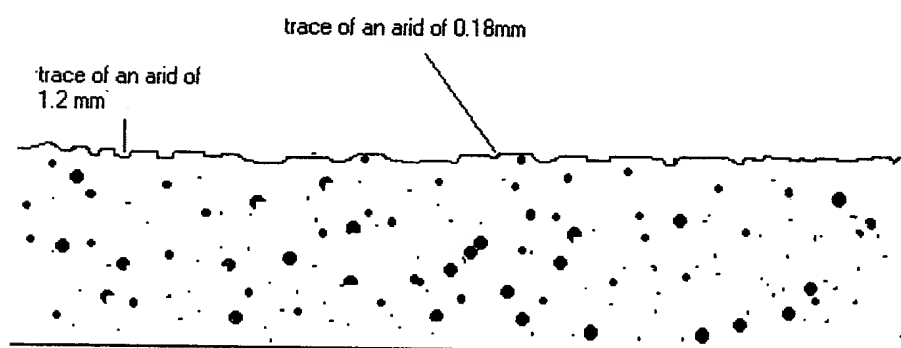


Arids sizes:

● 1.20 mm

○ 0.18 ~0.20 mm

Sliced view of an enlarged one-coat mortar
(prior devastation)



Sliced view of an enlarged one-coat mortar
(after the devastation)